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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Virgin Records America, Inc.

Serial No. 75/169,685
Serial No. 75/178,317

Henry Klein of Ladas & Parry for Virgin Records America, Inc.

Elizabeth Pasquine, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney)

Before Cissel, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 20, 1996, Virgin Records America, Inc. filed two applications, both for "entertainment services, namely, live performances as a musical group." Application Serial No. 75/169,685 is for the mark SCARFACE, with a claimed date of first use of 1991; and application Serial No. 75/178,317 is for the mark GETO BOYS, with a claimed date of first use of 1989.

Registration has been finally refused in each case on the grounds that (i) the specimens submitted by applicant do not show use of the marks for services, but rather evidence trademark use for goods, and (ii) applicant's proposed amendment to the identifications of services cannot be allowed.

Applicant has appealed, and briefs have been filed. An oral hearing was not requested by applicant.

Applicant's motion for consolidation (which was filed after all briefs had been filed in both cases) was granted by the Board on January 28, 1999. Therefore, we issue this single opinion. We affirm the refusals to register in both cases.

In both applications, the method-of-use clause reads as follows: "The manner or mode of use of the mark on or in connection with the services is by applying the mark to fliers, labels and promotional material used on or in connection with the services and in other customary ways." The specimens submitted by applicant are labels from a cassette tape and inserts packaged inside the cassette tape. Applicant has not submitted any substitute specimens.[1] The specimens of record show the name SCARFACE

[1] During the prosecution of the applications, the Examining Attorney suggested that applicant simply submit materials

or GETO BOYS, respectively; the names of the songs on the tapes; copyright information and warnings; and photographs of the covers of other tapes or CDs by SCARFACE or GETO BOYS. The package inserts (in the GETO BOYS application, Serial No. 75/178,317) show on one side pictures of the artists, and on the other side there is a listing of each song with credits for writing, production and the like, and pictures of clothing items that can be purchased by telephone.

The Examining Attorney's position is essentially that the specimens show use of the marks on goods, but are not acceptable to demonstrate use of the mark in association with the recited entertainment services as required by Section 45 of the Trademark Act and Trademark Rule 2.58; and that applicant's proposed amendment to the identifications of services ("entertainment in the nature of a musical group") cannot be allowed as it does not recite a service with sufficient specificity.

Applicant essentially contends that there is a less stringent requirement for specimens for services; that the

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advertising the group's concerts or photographs of the group performing with the mark prominently displayed which would support service mark usage of these marks. Applicant declined to do so.

cassette inserts[2] support use of the marks for entertainment services in the nature of live performances because cassettes, CDs and records are used in the sale or advertising of the entertainment services and thus, they embody recordings of live performances; and that applicant's proposed identification of services properly identifies a service as contemplated by the Lanham Act.[3]

The requirements for specimens of use of a mark in connection with services differ from the requirements for specimens of use of a mark in connection with goods. Although service marks are used *in connection with* the services, trademarks appear *directly on* the goods or on the containers or labels for the goods. Implicit in the

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[2] In the separate appeal briefs, applicant refers to the inserts as "CD inserts." However, the specimens of record are not CD inserts, they are cassette tape labels and inserts.

[3] First, we note that in applicant's separate reply briefs, applicant specifically stated that the recitation of services issue was "prematurely made final," but applicant "defers to the opinion of the Trademark Trial and Appeal Board to address the matter rather than forcing a remand." (Reply briefs, footnotes 1 and 2, respectively).

Second, applicant specifically requested in its separate briefs on the case that if the Board does not accept the specimens of record as evidence of service mark use, that the Board accept them as evidencing trademark use and amend the identifications of services in both applications to "compact discs, records, audio and visual (sic) pre-recorded tapes, DVD's, all featuring rap music." The request is denied. See TBMP §804.10(b) and (c). Applicant's identifications of services were clear and unambiguous as filed and were accepted by the Examining Attorney. TBMP §804.10(c) is very clear that *"[A]n applicant may not amend a definite identification of goods to specify services, or vice versa."* (Emphasis in original.)

statutory definitions of a "service mark" is the requirement that there be some direct association between the mark and the services, i.e., that the mark be used in such a manner that it would readily be perceived as identifying the source of such services. See In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); and In re Adair, 45 USPQ2d 1211 (TTAB 1997).

In this situation, we agree with the Examining Attorney that the specimens submitted by applicant do not show the marks sought to be registered used by applicant in connection with the services identified in the applications. Rather, the specimens of record evidence use as a trademark in connection with audio recordings. The fact that musical groups named SCARFACE and GETO BOYS have recorded songs on cassette tapes which indicate the tapes were "Manufactured by Virgin Records America, Inc." simply does not show the marks used to identify the rendering of entertainment services, namely live performances as a musical group. The cassette labels and inserts include no statement or any other indication that they are recordings of a live performance outside of a recording studio (e.g., "recorded live at...."). That is, the specimens of record do not support use of the marks in connection with the

identified services because they do not show applicant's use of the marks in association with the sale or advertising of the services specified in the applications. Cf. In re Carson, 197 USPQ 554 (TTAB 1977).

Decision: The refusals to register on the basis that the specimens do not show use of the marks as service marks is affirmed in both applications.[4]

R. F. Cissel

C. E. Walters

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

[4] Applicant's request that both identifications of services be amended to read "entertainment in the nature of a musical group" is denied. First, it would be futile to allow the amendment because of our finding that these specimens are not acceptable as evidence of use in connection with any services. Second, the proposed amendment in each case is broader than the original identification of services (which is limited to live performances), and therefore, is prohibited under Trademark Rule 2.71(b). See also, In re Swen Sonic Corp., 21 USPQ2d 1794 (TTAB 1991). Moreover, the proposed amendment is indefinite as it is insufficiently specific. For example, it could include every type of service which could be rendered by a musical group, including live performances, or a series of television variety shows.